

Remarks

A. Response to claim rejections under 35 USC 112.

Claims 5-7 were rejected under 35 U.S.C. §112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action pointed out that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite.

Applicants have amended claims 5-7 and therefore respectfully request that the rejections of claims 5-7 under 35 U.S.C. 112 be reconsidered and withdrawn.

B. Response to claim rejections under 35 U.S.C. § 102.

Claims 1-3 were rejected under 35 U.S.C. § 102 as being anticipated by Heene et al. (U.S. Pat. 6,425,831).

In particular, regarding claims 1 and 3, the Office Action asserted that Heene et al. disclose "a golf club head comprising a recess having a polymer insert wherein the polymer insert is composed of a transparent polymer material with a thickness of 0.125 or 0.500 inches, or 3.175 to 127 mm, and having a gloss and lustrous surface and wherein the recess being formed in the striking plate of a putter head and the insert is made of a thermoplastic polyurethane." Regarding claim 2, the Office Action asserted that Heene et al. disclose that a polymer insert has a pattern or logo inside the polymer insert.

To the extent the rejections may be applicable to currently amended claims, Applicants respectfully traverse.

Heene et al. merely disclose that "the insert is composed of a polyurethane materials" (Heene et al., col. 4, ll. 23-24) and such polymer materials "include ionomers, polyetheramides, thermoplastic polyurethanes, and the like." (Heene et al., col. 4, ll. 29-31). However, Heene et al. do not teach a thermoplastic polymer materials selected from the group consisting of polymethacrylate, polyacrylate, polycarbonate, polyethylene terephthalate, transparent polypropylene, transparent polyethylene, transparent polyvinyl chloride, transparent nylon, and the mixtures thereof. Accordingly, Heene et al. do not teach the claimed thermoplastic polymer materials in the present invention.

Applicants further note that Heene et al. teach that a pattern or logo is printed on the external surface of the polymer insert (See, Heene et al., Figs. 9 & 10, col. 2, ll. 45-47, col. 3, ll. 13-19; col. 6, ll. 4-21). In particular, Heene et al. teach that an indicia forming a pattern or logo is printed directly on the top coat which is applied over a base coat and creates a dual coated external surface (Heene et al. Fig. 9, col. 6, ll. 10-11 & 5-6). Heene et al. also teach that an indicia is printed directly onto a base coat and is then covered by a top coat and a multitude of external surface structures will be recognized by skilled artisans. (Heene et al., Fig. 10, col. 13-15 & 18-20). However, Heene et al. does not teach that a pattern or logo is under or inside a polymer insert.

In light of the foregoing, Heene et al. do not teach each and every elements of the claimed invention. Accordingly, Applicants respectfully request that the rejections of claims 1-3 under 35 U.S.C. § 102 be reconsidered and withdrawn.

C. Response to claim rejections under 35 U.S.C. § 103(a).

Claims 4-7 are rejected under 35 U.S.C. § 103(a) as being obvious over Heene et al. To the extent that the rejections may be applicable to currently amended claims, Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

In making the rejections, the Office Action asserted that "one having ordinary skill in the art would have found the selection of material to be an obvious matter of design choice. Any material, including the materials disclosed by Heene et al., would perform equally as well so long as the material is transparent." Applicants are not certain whether the assertion is based on common knowledge in the art or well known prior art, since Applicants find no adequate evidence in the Office Action to support the assertion. It is not permissible to use knowledge gleaned from applicant's own disclosure at hindsight. Therefore, Applicants respectfully request that documentary evidence be provided in support of the assertion. In the absence of the evidence, there lack the knowledge generally available in the art to modify Heene et al. and render the claimed invention in the present application.

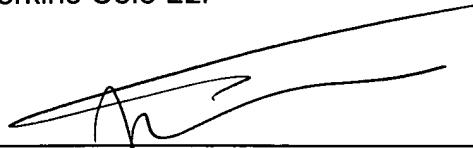
Applicants further note that Heene et al. does not teach or suggest the claimed transparent polymer insert. Quite to the contrary, Heene et al. teach that "the natural color of the insert is white or an off-white, and the insert may be painted with a base coat to enhance its white color." (Heene et al., col. 4, ll. 39-41). It appears that Heene et al. teach away from a transparent polymer insert, much less all claim limitations.

In light of the foregoing, in the absence of aforementioned documentary evidence, Applicants respectfully request that the rejections be reconsidered and withdrawn.

Conclusion

In light of the foregoing, it is submitted that the present claims are in condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,
Perkins Coie LLP


James J. Zhu
Registration No. 52,396

Date: January 7, 2005

Correspondence Address:

Customer No. 34055
Patent – LA
Perkins Coie LLP
P.O. Box 1208
Seattle, Washington 98111-1208
Telephone: (310) 788-9900
Facsimile: (206) 332-7198